

### REMARKS

Claims 1-12, 14-39, 41-69, 81-88, and new claims 90-94 are pending in the application. Claims 19, 23-24, 47, 51-52, 54-57, 64-65, and 81 have been amended and new claims 90-94 have been added. Claims 1-12, 14-18, 27-39, 41-46 and 83-88 have been withdrawn from consideration. Claims 19-26, 47-69, 81 and 82 have been rejected.

### **The Amendments**

Claims 19, 47, 57, 65, and 81 have been amended to indicate that the roughened or textured surface is a non-unitary surface. New claims 90-94 have been added to indicate that the non-lenticular surface has the surface texture of either a football or a basketball. Support for this terminology is present in the specification at, for example, the following locations:

- Page 3, lines 15-20 (“Texture or roughened surface blank **10** comprises an ordered or random set or collection of features **21** on its outer (in the Figure, its upper) or front face; the size and number of features **21** may or may not be coordinated with the images that form the image layer **30**. Generally, circular cross-sectional features are illustrated and preferred, but other shapes are within the scope of the invention.”);
- Page 6, lines 22-26 where it is stated that textured or roughened materials other than lenticular materials may be used;
- Page 16, lines 17-20 (“An in-mold decorated article that has a desired textured or roughened surface (for example, that like a football or a basketball) and custom . . .”); and
- Page 34, lines 6-8 (This provides decorated article that has a desired texture, for example, that of a football or basketball, with custom graphics behind the texture.”).

These disclosures teach that the textured or roughened surface is preferably a non-lenticular surface. Thus, the textured or roughened surface does not use any significant level of lenticules. Lenticules, as taught in the art (See U.S. Patent 5,967,032), comprise convex lenses formed in a side-by-side arrangement with the lenticules extending parallel to each other the length of the web. Different lens materials have a different number of lenticules per inch (LPI) with the particular LPI selected depending upon the particular application. The present invention does not employ such lenses.

### **Withdrawn Rejections**

The Applicant acknowledges that the following rejections have been withdrawn;

- (a) The 35 U.S.C. 112 rejections of claims 25 and 57-64 of record in the Office Action mailed October 17, 2006, pages 2-3 Paragraph 4; and
- (b) The U.S.C. 102 rejections of claims 65-67 and 69 as anticipated by Goggins '196 of record in the Office Action mailed October 17, 2006, pages 6-9.

### **Remaining Rejections**

#### **Double Patenting**

Claims 19-26, 47-56 and 65-69 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 7,153,555. The Examiner argues that although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of claims 19-26, 47-56 and 65-69 are all taught by the claims in Patent '555 except for certain differences, which are all obvious changes.

Applicant disagrees with the Examiner's position, but in the interest of facilitating examination of this application, offers to file a Terminal Disclaimer with respect to U.S. Patent No. 7,153,555 once the Examiner indicates that the claims are allowable.

Claims 19-26, 47-69 and 81-82 are provisionally rejected on the ground of non-statutory obviousness-type double patent pending as being unpatentable over claims 19-26, 47-69 and 81-82 of co-pending Application No. 10/472,054.

Applicant offers to file a Terminal Disclaimer with respect to co-pending Application No. 10/472,054 if that application matures into a patent before the subject matter of the present application is indicated as allowable by the Examiner.

#### **Claim Rejections – 35 USC § 112**

Claims 23-24, 51-52, 54-56 and 62-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended claims 23, 24, 51, 52, 54, 55, 56, 62, 63, 64, and 65. It is submitted that these amendments overcome this rejection.

### **Claim Rejections – 35 USC § 102**

Claims 19-26, 47-54, and 65-69 are rejected under 35 U.S.C. 102(b) as being anticipated by Guest (US 2002/0114080 A1, corresponding to U.S. Patent 6,490,093).

Claims 19-21, 23, 25-26, 47-49, 51 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Goggins (WO 01/96079 A2, corresponding to U.S. Patent 6,635,196).

Claims 57-59 and 61-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Goggins (WO 01/73497 A2).

Claims 19-26, 47-54 and 65-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Raymond et al (USPN 7,153,555)

Claims 19-26, 47-69, and 81-82 are rejected under 35 U.S.C. 102(e) as being anticipated by McCannel et al (US 2004/0095648 A1).

Applicant submits that each of these rejections is moot in view of the amendments to the claims. None of the references relied upon by the Examiner in support of these rejections disclose the use of non-lenticular lenses. To the contrary, they each disclose the use of lenticules that comprise convex lenses formed in a side-by-side arrangement with the lenticules extending parallel to each other the particular article taught. As a result, these references each fail to teach the use of an essential element of the claims and cannot support the Examiner's rejections under 35 U.S.C. 102(a) or (e).

### **Claim Rejections – 35 USC § 103**

Claims 54-56 and 81-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goggins (USPN 6,635,196).

Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guest (USPN 6,490,093).

Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al (USPN 7,153,555).

Claims 60 and 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goggins (USPN 6,490,092) in view of Guest (USPN 6,490,093).

Applicant submits that the Examiner has failed to provide a *prima facie* case of obviousness with respect to any of these rejections. As noted above, these references only disclose the use of lenticular surfaces that comprise lenticules that are made up of convex lenses formed in a side-by-side arrangement with the lenticules extending parallel to each other. They disclose nothing about the use of non-lenticular textured or roughened surfaces such as, for example, the non-linear texture of the surface of a football or a basketball.

It is submitted that non-lenticular surfaces of the type required by the present claims are contrary to the disclosures of these references. They all disclose interlacing the image on the back of the lenticular lens layer so that the image can be lined up with the lenticules and provide a desired optical effect when the object is moved. This teaches that the top surface should not employ non-lenticular lenses, as they would interfere with proper viewability of the image. Accordingly, one would not be led to use non-lenticular lenses. Thus, these references fail to motivate one to use such images and they do not support the Examiner's rejections.

### CONCLUSION

Based upon the above remarks, it is believed that the rejections have been shown to be inappropriate. Accordingly, reconsideration of those rejections and allowance of all pending claims are respectfully requested.

Respectfully Submitted,

Dated: August 16, 2007

By: James V. Lilly  
James V. Lilly, Reg. No. 27,817  
Customer No. 33072  
Phone: 651-275-9844  
Facsimile: 651-351-2954